

Application No. 09/514,699

Paper No. 4, dated July 23, 2001 to show nonobviousness, nor responding under 35 U.S.C. 102, as alleged by the Examiner in Paper No. 7. Applicants have previously asserted and continue to assert that the Examiner has not established a *prima facie* case of obviousness. The Examiner has failed to point out any suggestion in Wellings or Lane any suggestion, motivation, or incentive to modify or combine the references.

Wellings does not teach the liquid developer reconstitution compound recited in claim one. Wellings does not teach the use of a second liquid developer. Additionally, Wellings does not teach the dispersion of a first and second liquid developer. Further, Welling does not teach the formation of a second liquid developer by dispersion of a first liquid developer concentrate in a carrier liquid into additional carrier liquid. Still further, Welling does not teach redispersing the reclaimed undeveloped developer cake in a second developer liquid.

When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Uniroval Inc. v. Rudkin Wiley Corp., F. 2d, 5 U.S.P.Q. 2d 1435 (Fed. Cir. 1988); Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention. Uniroval Inc. v. Rudkin Wiley Corp., F. 2d, 5 U.S.P.Q. 2d 1435 (Fed. Cir. 1988); W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F. 2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

The Examiner appears to have considered various portions of the references cited, in each instance viewing the cited portion in isolation from the context of the entire reference, and combined these isolated portions to arrive at the present invention with the benefit of hindsight. Using hindsight or applying the benefit of the teachings of the present application when determining obviousness, however, is impermissible; the references applied must be reviewed without hindsight, must be reviewed as a whole, and must suggest the desirability of combining the references. Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 221 U.S.P.Q. 481 (Fed. Cir. 1984). There is not suggestion in the cited reference to combine elements in the manner suggested by the Examiner. The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in

Application No. 09/514,698

the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure. In re Dow Chemical, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988). There is no suggestion in Wellings, Lane, nor Liu to combine the disclosures in the manner articulated by the Examiner. Without such a suggestion, there can not be any expectation of success.

Liu does not teach the use of a second liquid developer. Liu does not teach redispersing of the reclaimed undeveloped developer cake in a second liquid developer. Further, Liu does not teach or suggest the use of a second liquid developer which is dielectric.

None of the cited references suggests or teaches the desirability of combining the elements of the present invention as claimed. Obviousness cannot be established by combining references to arrive at the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In re Gelger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987); Carrella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. (BNA) 929 (Fed. Cir. 1984).

In the instant application, the Examiner indicates that it would have been obvious for a person having ordinary skill in the art to combine the liquid developer concentrate comprising a surfactant as disclosed by Lane with the teachings of Wellings and/or Liu to arrive at the applicant's invention. The Examiner has not provided any reason or suggestion for the combination other than the hindsight taken from the applicant's invention. There is no suggestion in Wellings, Liu, or Lane for such a combination. The Examiner has stated that Lane's liquid developer concentrate meets Wellings requirements of a liquid developer concentrate and that Lane teaches that his liquid developer concentrate can be easily dispersed and eliminates the need for frequent disposal of liquid from the developing apparatus. The fact that the prior could have been modified does not make the modification obvious when there is no suggestion of the desirability of such a modification.

The Examiner is using Appellant's disclosure as a recipe for selecting the appropriate portions of the prior art to construct Appellant's invention. A

Application No. 09/514,699

piecemeal reconstruction of the prior art patents in light of Appellant's disclosure is not a basis for a holding of obviousness. In *re Kamm et al.*, 172 U.S.P.Q. 298 (C.C.P.A. 1972). The mere fact that the prior art devices could have been modified does not make the modification obvious unless the prior art suggested the desirability of such a modification. In *re Gordon*, 221 U.S.P.Q. 1125, (Fed. Cir. 1984); *Jones v. Hardy*, 220 U.S.P.Q. 1021, (Fed. Cir. 1984). It is clear that the combination of patents does not suggest that the modifications proposed by the Examiner be made.

As the Court of Appeals for the Federal Circuit stated in *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal Inc.*, 56 USPQ2d, 1641 (Fed. Cir. 2000) at 1644:

This court has recently reemphasized the importance of the motivation to combine:

As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In *re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (Internal citations omitted).

01-15-2002 08:55am From-

T-114 P.007/008 F-024

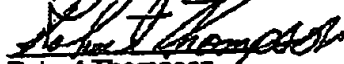
Application No. 09/014,699

Accordingly, reconsideration and withdrawal of the rejection under 35 USC 103 is respectfully requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, the Examiner is hereby authorized to call Applicant's Attorney, Robert Thompson, at Telephone Number (716) 423-2050, Rochester, New York.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No.24-0025.

Respectfully submitted,

  
Robert Thompson  
Attorney for Applicant  
Registration No. 47,137

R-T/pn  
Xerox Corporation  
Xerox Square 020  
Rochester, New York 14644

01-18-2002 09:55am From-

T-114 P.006/008 F-024

Application No. 09/514,000

**VERSION WITH MARKINGS TO SHOW CHANGES MADE:**

3. (Amended) A process in accordance with claim 1, further comprising [where] ~~wherein~~ the developer cake on the [a] liquid receiver member is charged by a corona charger prior to developing the image.

10. (Amended) A process in accordance with claim 1, wherein the reclaimed undeveloped developer cake is separated from the second liquid developer until the solids content of the second liquid developer drops below from about 6 to about 10 weight percent.